

REMARKS

Election/Restriction

The Office Action alleged as follows:

[I]n unity of invention practice, restriction is proper in a US national stage of a PCT application where the special specification technical feature does not make a contribution over the prior art. In this application, the compound of claim 1, which is the special specification technical feature, is taught by the prior art and therefor does not make a contribution over the prior art. Therefore restriction of claim 11 is proper.

The Restriction dated June 4, 2008 was based on allegation that the claims did not related to a single general inventive concept under PCT Rule 13.1 because claim 1 is anticipated or obvious over a prior art reference. Thus, the basis of restriction depends on the issue on the merits. Applicant provisionally elected, with traverse, Group 1, claims 1-7, drawn to compound.

The rule 37 CFR 1.475(b)(3) provides as follows:

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

...
(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; . . .

Claims 1-3 are directed to the product; claim 7 is directed to the “process specially adapted for the manufacture of the said product”; and claims 8-10 are directed to “use of the said product.” Thus, the claims satisfy the combination of categories provided under and satisfy unity of invention.

Oath/Declaration

The declaration is objected to because of informalities.

The Office Action alleged as follows: "The oath or declaration is defective because: the foreign priority claimed block is not checked."

First, the declaration does specifically claim priority to Japanese patent application. The declaration includes the country, filing date as well as the number of Japanese patent application 2002-087738 and the following statement:

I hereby claim foreign priority benefits under Title 35 United States Code § 119(a)–(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application for which priority is claimed.

(Emphasis added). There is no reason to interpret that the claim to foreign priority in the international stage is withdrawn without any specific statement to the effect in the declaration.

Second, claim for priority based on a prior foreign application is not required to be specifically claimed in the declaration. The MPEP states at 1893.03(c) as follows:

RIGHT OF PRIORITY UNDER 35 U.S.C. 119(a) and 365(b)

Pursuant to 35 U.S.C. 365(b) a U.S. national stage application shall be entitled to a right of priority based on a prior foreign application or international application designating at least one country other than the United States in accordance with the conditions and requirements of 35 U.S.C. 119(a) and the treaty and the PCT regulations. See in particular PCT Article 8 and PCT Rules 4.10 and 26bis. To obtain priority in the U.S. national stage application to such applications, the priority must have been timely claimed in the international stage of the international application. See 37 CFR 1.55(a)(1)(ii). **If priority was properly claimed in the international stage of the international application, the claim for priority is acknowledged >(subject to the paragraph below)< and the national stage application file is checked to see if**

the file contains a copy of the certified copy of the priority document submitted to the International Bureau.

(Emphasis added).

Nevertheless, “Claim for Foreign Priority” will be submitted with the response.

Thus, the objection to the declaration should be withdrawn.

Rejections under 35 USC §102(b) and 103(a)

Claims 1 and 4-7 are rejected under 35 USC §102(b) as being anticipated by, or, in the alternative, under 35 USC §103(a) as obvious over Lacerda et al. (Solid State Ionics, 59 (1993), pp. 257-263).

Claim 1-3 has been amended to further recite “which has an electronic conductance equivalent to an electric conductivity of 10^{-5} Scm^{-1} or more.”

Lacerda et al. discusses electrical properties of C12A7. However, nothing in Lacerda et al. indicates that the material has an electronic conductance equivalent to an electric conductivity of 10^{-5} Scm^{-1} or more. Also, nothing in Lacerda et al. indicates that the material is irradiated with ultraviolet light.

In contrast, the C12A7 has an electronic conductance equivalent to an electric conductivity of 10^{-5} Scm^{-1} or more. Moreover, in order for the C12A7 to have such an electronic conductance, the C12A7 has to be made through a special treatment such as described in the specification at pages 6-7.

The C12A7 is rather an insulative material having an electric conductivity of $10^{-10} \text{ Scm}^{-1}$ or less. In response to irradiating the specially treated C12A7 material with ultraviolet light having a wavelength of about 300 nm, the conductivity starts to increase, and the irradiated material will exhibit an electronic conductance of 10^{-5} Scm^{-1} or more.

For at least these reasons, claim 1 patentably distinguishes over Lacerda et al. Claims 4-7, depending from any one selected from claim 1 also patentably distinguishes over Lacerda et al. for at least the same reason.

Also, claims 2 and 3 are both indicated as allowable. Therefore, claims 4-7, depending from claims 2 or 3 also are allowable.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

Application No.: 10/511,715
Art Unit: 4162

Amendment under 37 C.F.R. §1.111
Attorney Docket No.: 042834

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read "Sadao Kinashi", with a stylized flourish at the end.

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SK/ar
Attachment: Claim for Foreign Priority